

### REMARKS

In the Office Action dated February 25, 2005, claims 21, 22, 24-29, 35-42, and 54-59 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,116,063 (Foslien) in view of U.S. Patent No. 6,480,391 (Monson); and claims 60-62 were rejected under § 103 over Foslien in view of U.S. Patent No. 5,596,556 (Luffel) and U.S. Patent No. 6,160,786 (Coffin).

Applicant acknowledges the indication that claims 43-53 would be allowable if rewritten in independent form. Claims 43, 47, 50, and 53 have been amended from dependent form to independent form, with their scope *unchanged*, to place these claims in condition for allowance.

**Entry of this Amendment is respectfully requested as it removes issues from appeal.**

It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to the rejected claims for at least the two following reasons: (1) there existed no motivation or suggestion to combine Foslien and Monson to achieve the claimed invention; and (2) even if they can be combined, the hypothetical combination of Foslien and Monson does not teach or suggest all elements of the claims. *See* M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 2), at 2100-129.

Independent claim 36 is addressed first. Claim 36 recites a data storage system comprising a data storage system housing having an opening and reference rails located adjacent the opening, and a media storage device *for storing a plurality of data media*. The media storage device includes a media storage device housing having *alignment grooves*, each of which is adapted to slidably engage with a respective one of the *reference rails* such that the media storage device may be inserted into and removed from the data storage system housing by slidably engaging the reference rails and the alignment grooves and guiding the media storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing.

Figs. 2 and 3 of Foslien depict a data storage system that has a drawer 54 with slots 56, 58 for receiving data storage media 60, 62. Foslien, 4:60-5:6. Although an unlabelled structure is depicted underneath the drawer 54 to enable movement of the drawer 54 into and out of the housing 30 (see Fig. 2), there is no teaching of the drawer 54 having alignment grooves for engaging reference rails of the housing 30, a point that was conceded by the Office Action. 2/25/2005 Office Action at 3.

However, the Office Action relied upon Monson as teaching the missing features. Specifically, the Office Action referred to grooves in a DASD tray 95 depicted in Figs. 3 and 4 of Monson. It is respectfully submitted that this reliance is misplaced, as Monson also fails to disclose a media storage device for storing a plurality of data media that has alignment grooves for slidably engaging respective reference rails. As depicted in Figs. 3 and 4 of Monson, the DASD tray 95 having springs 135 is provided onto guide rails 100 of a cage 10. Although indentations are depicted in Fig. 3 in the DASD tray 95 housing of Monson, these indentations are used to receive springs 135. There is absolutely no indication that the indentations receiving springs 135 are designed to engage any structure in the cage 10 of Monson. The alignment springs 135 of Monson are designed to engage a roof member 50 and floor member 40 of a cage to achieve optimal compression of the springs 135. Monson, 7:13-21. In other words, it is the springs 135 of Monson that are designed to engage the roof and floor of the cage 10. There is absolutely no indication whatsoever that the indentations for receiving the springs 135 are designed to engage any type of reference rails. In view of this, it is respectfully submitted that no motivation or suggestion existed to combine the teachings of Foslien and Monson to achieve the claimed invention.

Moreover, note that the DASD tray 95 is an individual storage device, not a media storage device for receiving *a plurality of data media*. As indicated in the previously cited Webopedia, the ordinary definition of the term “direct access storage device” or “DASD” is “another name for disk drive in the world of mainframes.” In fact, as Monson expressly states, DASDs are “individually disposed within a so-called ‘sled’ or tray.” Monson, 1:14-17. Thus, what Monson would have suggested to a person of ordinary skill is that springs 135 can be provided on *individual* DASD trays. Note that claim 36 recites that the housing of a media storage device, which stores a *plurality* of data media, has alignment grooves. In contrast, Monson teaches the use of springs 135 on an individual DASD tray 95 for alignment of the DASD tray. Monson, 7:18-21. Thus, there existed no suggestion in Monson of providing alignment grooves on a media storage device used for storing a plurality of media. For this additional reason, no motivation or suggestion existed to combine Foslien and Monson.

Furthermore, the springs 135 (on the DASD trays) and guide rails 100 (of a cage) of Monson are intended for use to align multiple DASD trays in the cage. This concern of aligning multiple DASD trays in a cage is simply not applicable to the drawer 54 of Foslien. Thus,

clearly, no motivation or suggestion is provided by Monson to modify the structure of the drawer 54 of Foslien to achieve the claimed invention.

Moreover, as the drawer 54 of Foslien does not have alignment grooves for engaging reference rails of the housing 30, and the DASD tray 95 of Monson also does not have a media storage device for storing a plurality of data media, where such a media storage device has alignment grooves for engaging reference rails, the hypothetical combination of Foslien and Monson fails to teach or suggest each and every element of claim 36.

The Office Action argued that the claim language “fails to provide adequate structural limitations in order to distinguish applicant’s invention from Foslien in view of Monson,” referring to the distinction between the “individual storage device” of Monson and “media storage device” of claim 36. 2/25/2005 Office Action at 7. Applicant respectfully submits that claim 36 unambiguously and explicitly claims a media storage device for storing a *plurality* of data media, and that such media storage device (for storing the plurality of data media) has a housing with alignment grooves for engaging respective reference rails. Clearly, neither Foslien nor Monson discloses or suggests such a media storage device. Therefore, the hypothetical combination of Foslien and Monson clearly fails to teach or suggest the claimed invention.

For the foregoing reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 36.

Independent claim 21 is similarly allowable over the asserted combination of Foslien and Monson.

Independent claim 60, rejected as obvious over Foslien, Luffel, and Coffin, recites a data storage system including a data storage system housing having an opening and reference structures, and a media storage device for storing a plurality of data media devices. The media storage device has a housing with alignment structures to slidably engage the respective reference structures to enable slidable movement of the media storage device through the opening of the data storage system housing. Moreover, the data storage system has a moveable media exchange device to receive the media storage device, where the media exchange device is moveable between a retracted position and an extended position. The media storage device is positioned inside the data storage system housing when the media exchange device is in the retracted position, and the media storage device protrudes from the data storage system housing when the media exchange device is in the extended position. In addition, the data storage system

further includes guide structures to moveably guide the media exchange device between the retracted and extended positions.

The Office Action conceded that Foslien does not disclose a moveable media exchange device to receive the media storage device, as recited in claim 60. 2/25/2005 Office Action at 5. Note that the media exchange device of claim 60 is moveable between a retracted position (where media exchange device is positioned inside data storage system housing) and an extended position (where media exchange device protrudes from the data storage system).

The Office Action further stated that such a moveable media exchange device was “well known,” without citing to specific support for the “well known” statement. *Id.* Then the Office Action cited Luffel and Coffin as teaching the recited media exchange device, without citing to any specific passage of Luffel or Coffin. *Id.* Such an obviousness rejection is defective, as insufficient support has been provided in the Office Action for a rejection. Therefore, a *prima facie* case of obviousness has not been established.

Moreover, both Luffel and Coffin refer to use of a cartridge engaging assembly (18 in Fig. 1 of Luffel, and 10 in Fig. 1 of Coffin). It is unclear whether the Office Action is equating the moveable media exchange device of claim 60 with such cartridge engaging assemblies.<sup>1</sup> Note that the cartridge engaging assembly of each of Luffel and Coffin moves entirely within the data storage system. Therefore, such cartridge engaging assemblies do not have an extended position where the cartridge engaging assemblies would protrude from the data storage system housing.

Moreover, the cartridge engaging assembly 18 of Luffel retrieves *one* of the cartridges 14 (Luffel, 4:39-41), and the cartridge engaging assembly 10 of Coffin engages *a* data cartridge 14 (Coffin, 4:16-19). Thus, the cartridge engaging assembly of Luffel or Coffin does not *receive* a media storage device for storing a *plurality* of data media devices.

Therefore, the *prima facie* case of obviousness is further defective because the hypothetical combination of Foslien, Luffel, and Coffin does not teach or suggest each and every element of claim 60.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the foregoing, withdrawal of the obviousness rejections and allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10012828-1).

Respectfully submitted,

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<sup>1</sup> As a result of the inadequate obviousness rejection over Foslien, Luffel, and Coffin, Applicant has to guess what element in Luffel or Coffin has been equated by the Office Action with the moveable media exchange device, which is a clear indication of the defectiveness of the rejection.